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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,913

08/01/2006

Hideji Tajima

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EXAMINER

LUDLOW, JAN M

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

10/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,913	<b>Applicant(s)</b> TAJIMA ET AL.	
	<b>Examiner</b> Jan M. Ludlow	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Ingenhoven (686971).

Ingenhoven teaches a device for aspirating and dispensing having a large diameter portion 3; a small diameter portion at the bottom of adapter 8'; a sliding section comprising piston 19, rod 4, and a connection section shown as a knob at the top of rod 4; and suction and discharge mechanism 11, 12, 13, 14. Sheath 8 is engaged with and covering all of the small diameter portion at the bottom of adapter 8'. See Figs 1-3.

6. Claims 4-7, 13-15, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingenhoven as applied to claims above, and further in view of Tajima (WO01/53839). Note that US 6,691,748 is relied upon as an English language equivalent translation of WO01/53839.

7. Ingenhoven fails to teach a container placement area, movement section, magnetic section or temperature controller.

8. Tajima teaches a device similar to that of Ingenhoven. A container placement area 12 is provided with stations for temperature control and magnetic treatment as claimed (see, e.g., abstract). Tips can be attached as claimed in step S103.

9. It would have been obvious to provide a container placement area with stations for temperature control and magnetic treatment as claimed in the device of Ingenhoven in order to perform processes such as PCR as taught by Tajima. In that Ingenhoven teaches moving the array of cylinders over the liquid sources (col. 7, lines 65-67), it

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would have been obvious to provide means for moving the cylinders instead of or in addition to means for moving the containers. With respect to claim 4, a fitting section, e.g., element 10 of Ingenhoven connects the cylinders to the suction and discharge mechanism, and it would have been obvious to make it detachable, e.g., in order to facilitate cleaning or replacement of parts. Recess 18 constitutes the instant gap elimination mechanism of instant claim 5 as a tight fit is shown. An O-ring can be provided between the small diameter section and sheath (col. 3, line 40) constituting the protruding engagement section of instant claim 6.

10. Claims 8-10, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingenhoven and Tajima as applied to claims above, and further in view of Gordon (2003/0026732)

11. The primary references fail to teach an optical system for detecting fluid level in the cylinders.

Gordon teaches a pipette system similar to that of Ingenhoven. Optical detectors 11110, 1112 are provided to detect liquid levels in the pipette cylinders to ensure accurate operation (Figure 11, abstract).

It would have been obvious to provide optical level sensors in the device of Ingenhoven in order to ensure accuracy as taught by Gordon. With respect to claim 9, it would have been obvious to use reflection using a mirror in place of transmission as was known in the art and to use a CCD as a known light detector. With respect to claim 10, it would have been obvious to make the detectors moveable, e.g., in order to facilitate desired positioning, replacement or removal.

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12. Claims 11-12, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingenhoven and Tajima as applied to claims above, and further in view of Chow (5275951).

13. The primary references fail to teach a barcode on the containers.

14. Chow teaches a barcode on a multiwell plate for identifying the plate and storing information (col. 7, lines 60-68).

15. It would have been obvious to provide a barcode on the containers of Ingenhoven and Tajima in order to identify the plates for data collection as taught by Chow. It would have been obvious to make the barcode removable, e.g., in order to reuse the plates in order to reduce waste as was known in the art.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (571) 272-1260. The examiner can normally be reached on Monday, Tuesday and Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jan M. Ludlow  
Primary Examiner  
Art Unit 1797

/Jan M. Ludlow/  
Primary Examiner, Art Unit 1797